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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,501	08/09/2005	Kazunori Muta	28727U	6902
20529 7590 02/24/2010 THE NATH LAW GROUP 112 South West Street Alexandria, VA 22314				
EXAMINER				
ORWIG, KEVIN S				
ART UNIT		PAPER NUMBER		
1611				
MAIL DATE		DELIVERY MODE		
02/24/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/536,501

Applicant(s)

MUTA ET AL.

Examiner

Kevin S. Orwig

Art Unit

1611

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 January 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): The 112th paragraph rejection of claims 1-10 for NEW MATTER.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-10.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Kevin S. Orwig/
Examiner, Art Unit 1611

/David J Blanchard/
Primary Examiner, Art Unit 1643

Continuation of 11, does NOT place the application in condition for allowance because: The arguments presented by applicants are unpersuasive for at least the following reasons.

OBJECTIONS/REJECTIONS WITHDRAWN:

The rejection of claims 1-10 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in light of the claim amendments.

REJECTIONS MAINTAINED:

Claims 1-3, are rejected under 35 U.S.C. 103(a) as being unpatentable over IIDA.

RESPONSE TO ARGUMENTS:

Applicants argue that Iida does not teach each element of the claims. This argument was previously addressed and is unpersuasive for the reasons of record (see pgs. 5-6 of the previous Office Action). Applicants also argue unexpected results, pointing to paragraph [0006] of the pre-grant publication, and further argue differences in the irritation between Iida and the instant application. This argument is unpersuasive for the reasons of record (see pgs. 6-7 of the previous Office Action). Applicants are reminded that the instant claims are product claims, not method claims. Applicants are also advised that the phrase "as a residual irritation reducing agent" is merely intended use and is not afforded patentable weight. Thus, any product comprising the same ingredients reads on the claim regardless of its intended use or function. In this case, the prior art patches contain PEG, which is recognized for its anti-skin irritation activity. This is an inherent property of the compound, and it would treat any skin irritation regardless of whether or not such an effect is recognized in the prior art. Thus the prior art patches would have the instantly claimed effect on skin irritation (residual or not). In response to applicants' argument that the prior art does not recognize a benefit regarding residual skin irritation from using substantially the same patches, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Also, see MPEP § 2145: (Prima Facie Obviousness Is Not Rebutted by Merely Recognizing Additional Advantages or Latent Properties Present in the Prior Art). Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. In *re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979). Moreover, it is noted that the passage in paragraph [0006] pointed to by applicants supports the examiner's position since the passage admits that PEG "functions as a residual irritation-reducing agent which largely reduces the residual irritation...after the patch is peeled off." Thus, applicants own specification establishes that PEG has this function, precisely as suggested in the prior Office Action. It is further noted that Table I, referred to by applicants, is not commensurate in scope with the instant claims.

Claims 1-3, 4, 5, and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over MORI in view of WEISS and OKAMOTO.

RESPONSE TO ARGUMENTS:

Applicants assert that the cause of the skin irritation in Mori is different than that of the instant application and that Mori allegedly teaches PEG as a moisturizer. Again, applicants are advised that the phrase "as a residual irritation reducing agent" is merely intended use and is not afforded patentable weight. Nonetheless, it is undisputed that PEG is recognized in the art as a skin irritation reducing agent (see pg. 10 of the prior Office Action). As discussed above, and admitted by applicants, PEG inherently possesses the feature that is allegedly missing from Mori.

Applicants argue that the homopolymer of Weiss is somehow different than the instantly claimed PEG. It is noted that applicants do not point to any portion of Weiss to support their assertion. Rather, homopolymers of Weiss ARE polyethylene glycol (polyethylene oxide = polyethylene glycol) (see col. 1, lines 54-68), and are exactly the same as the PEG claimed. Applicants further argue unexpected results, attempting to argue that PEG, which is well-known to have skin irritation reducing properties, would not be expected to reduce "residual" skin irritation. Not only would such a result be expected, but applicants own specification establishes that this property is inherent to PEG as discussed above.

Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mori in view of Weiss, Okamoto, and Iida.

RESPONSE TO ARGUMENTS:

Applicants arguments with respect to Iida, Mori, Weiss, and Okamoto are addressed supra, and that discussion is incorporated herein..